UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,381	04/07/2000	Craig Spielmann	JPM-001	2456

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EXAMINER
VAN DOREN, BETH

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/545,381	SPIELMANN ET AL.
	Examiner	Art Unit	
	Beth Van Doren	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 June 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All   b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
    application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   The following is a final office action in response to communications received 06/06/05.

Claims 1, 10, 14, and 16 have been amended. Claims 1-18 are pending.

Response to Arguments

2.   Applicant's arguments with respect to the claims have been considered but are moot in

view of the new grounds of rejection, as necessitated by amendment.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 6-10, 12-13, 16, and 18 are rejected under 35 U.S.C. 102(e) as being

anticipated by Buddle et al. (U.S. 6,912,502).

4.   As per claim 1, Buddle et al. teaches a method for determining compliance with

organizational business policies associated with a business risk, said method comprising:

> a.   the computer receiving a user selection of a business risk element from a business
>
> risk element list which is displayed to the user, said business risk element list being
>
> retrieved from a database coupled to said computer (See figure 7, column 10, line 40-
>
> column 11, line 5 and lines 14-20 and column 13, lines 24-38, wherein the computer
>
> receives a compliance officer's selection of a risk element/compliance issue);

b.   in response to the selection of said business risk element, the computer retrieving one or more predetermined control procedures, the control procedures identified by an administrator as a means for complying with business policies associated with said selected risk element (See figure 1, column 2, line 60-column 3, line 25, lines 30-40, line 52-column 4, line 7, column 9, lines 50-65, column 13, lines 25-40, wherein business policies are discusses. See figure 4, column 7, lines 30-65, column 9, lines 10-35, which discuss control procedures that members of the business are questioned about);

c.   the computer associating said one or more predetermined control procedures with said selected business risk element, said predetermined control procedures being stored in said database (See figure 7, column 7, lines 40-60, column 9, lines 34-60, column 10, lines 30-55, and column 13, lines 25-37, wherein the control procedures are stored and associated with the risk element);

d.   in response to the retrieving of the control procedures, the computer retrieving a weight assigned to each one of said predetermined control procedures, said weight being stored in said database (See figure 4, column 8, lines 40-55, wherein a weight is assigned);

e.   the computer receiving a user selection of a compliance rating for each said predetermined control procedure, the rating selected by the user indicating a level of compliance with each one of said predetermined control procedures, for each of said predetermined control procedures the level of compliance is a subjective rating selected from a rigid set of compliance ratings, the same set of compliance ratings is available for each of said predetermined control procedures (See figures 4 and 5A, column 7, lines 40-

65, column 8, lines 32-55, wherein user selected ratings are provided to the control

procedures, these indicating a level of compliance); and

f.   the computer calculating a compliance score, each compliance score being a

function of said assigned weights and said compliance rating of said predetermined

control procedures (See figure 4, column 8, lines 35-55, wherein a compliance score is

calculated by the system).

5.   As per claim 2, Buddle et al. discloses wherein said compliance ratings comprise at least

one rating identifying a non-fully compliant control procedure, said method further comprising

the steps of:

a.   for each said control procedure having a non-fully compliant rating, the computer

receiving a user generated signal indicating whether said non-fully compliant control

procedure is accepted or not accepted (See column 8, line 56-column 9, line 33, wherein

the not fully compliant procedure is either accepted or not accepted (acted on or not acted

on)); and

b.   for each of said non-fully compliant control procedure which is indicated as not

accepted, requiring the user to provide signals for generating an action plan (See column

5, lines 17-46, column 9, lines 10-35, and column 10, lines 22-32 and 40-55, wherein the

user enters an action plan in the computer system).

6.   As per claim 6, Buddle et al. discloses associating one or more parameters with each said

compliance rating (See column 11, lines 60-67, which discloses parameters).

7.   As per claim 7, Buddle et al. teaches wherein said one or more parameters are selected

from the group comprising organization, business line, process, and region (See column 11, lines

60-67, which discloses such parameters).

8.   As per claim 8, Buddle et al. teaches the step of the computer sorting said compliance

scores by said one or more parameters (See column 11, lines 20-35 and line 60-column 12, line

5, which discloses sorting the scores).

9.   As per claim 9, Buddle et al. teaches the step of the computer displaying said sorted

compliance scores (See column 11, lines 20-35 and line 60-column 12, line 5 and lines 40-50,

wherein reports are displayed).

10.   As per claim 10, Buddle et al. teaches a method for determining compliance with

organizational business policies associated with a business risk, said method comprising:

        a.   a computer receiving a user selection of a business risk element from a business

        risk element list which is displayed to the user on a display terminal of a computer, said

        business risk element list being retrieved from a database coupled to said computer (See

        figure 7, column 10, line 40-column 11, line 5 and lines 14-20and column 13, lines 24-

        38, wherein the computer receives a compliance officer's selection of a risk

        element/compliance issue);

        b.   in response to the selection of said business risk element, the computer identifying

        one or more subrisk elements associated with said business risk elements, each subrisk

        element being retrieved from said database (See figure 4, column 8, line 55-column 9,

        line 10, which discloses sub-risk elements);

c.   for at least one subrisk element, the computer retrieving one or more

predetermined control procedures, the control procedures identified by an administrator

as a means for business policies associated with said subrisk element (See figure 7,

column 7, lines 40-60, column 9, lines 34-60, column 10, lines 30-55, and column 13,

lines 25-37, wherein the control procedures are stored and associated with the element);

d.   the computer associating said one or more control procedures with said subrisk

element, said control procedures being stored in said database (See figure 7, column 7,

lines 40-60, column 9, lines 34-60, column 10, lines 30-55, and column 13, lines 25-37,

wherein the control procedures are stored and associated with the element);

e.   the computer retrieving a weight assigned to each one of said predetermined

control procedures, said weight being stored in said database (See figure 4, column 8,

lines 40-55, wherein a weight is assigned);

f.   the computer receiving a user selection of a compliance rating for each said

predetermined control procedure, each said compliance rating is a subjective rating

selected from a rigid predetermined set of compliance ratings, the same set of compliance

rating is available for each of said predetermined control procedures including at least

one rating indicating said control procedure is not fully compliant (See figures 4 and 5A,

column 7, lines 40-65, column 8, lines 32-55, wherein user selected ratings are provided

to the control procedures, these indicating a level of compliance);

g.   the computer calculating a compliance score, said compliance score being a

function of said assigned weights and said compliance rating of said control procedures

(See figure 4, column 8, lines 35-55, wherein a compliance score is calculated by the system);

h.   for each subrisk, the computer determining whether at least one control procedure associated with said subrisk is not fully compliant (See figure 4 and column 7, lines 45-62, wherein the high risk areas are determined);

i.   for each subrisk associated with at least one control procedure which is not fully compliant, the computer receiving a signal from the user indicating whether said subrisk should be accepted or not accepted (See column 8, line 56-column 9, line 33, wherein the not fully compliant procedure is either accepted or not accepted (acted on or not acted on)); and

j.   for each subrisk which is indicated as not accepted, the computer generating an action plan (See column 5, lines 17-46, column 9, lines 10-35, and column 10, lines 22-32 and 40-55, wherein the user enters an action plan in the computer system and the computer generates a profile for this action plan).

11.   Claims 12 and 13 contain equivalent limitations to claims 6 and 8, respectively, and are therefore rejected using the art and rationale as applied above.

12.   Claim 16 is substantially similar to claim 1 and is rejected using the same art and rationale as applied above. Buddle et al. further teaches a database and a processor coupled to the database (See figures 6-7, column 12, lines 7-15 and 30-40, and column 13, lines 24-37).

13.   As per claim 18, Buddle et al. teaches a data processing system further comprising a computer display coupled to said processor, said processor further being programmed to display

said compliance scores on a computer display (See figures 6-7, column 7, lines 40-60, column

12, lines 1-15 and 30-49, and column 13, lines 24-37).

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 3-5, 11, 14, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Buddle et al. (U.S. 6,912,502).

15.   As per claim 3, Buddle et al. teaches wherein said action plan includes a target date, said

method further comprising the step of the computer expecting a changed compliance score for

one or more future dates based on said action plan target dates (See column 5, lines 15-30 and

39-51, column 9, lines 35-50, column 10, lines 23-42, column 11, lines 5-15 and 58-67, which

discusses target dates). However, while Buddle et al. discusses an expectation of decrease in a

future score, Buddle et al. does not expressly disclose calculating an expected compliance score

for the future date ahead of time.

Buddle et al. discloses identifying risk issues that need to be resolved in a timely manner.

Buddle et al. discloses calculating a current compliance score by utilizing the compliance ratings

and weights. This compliance score allows the user to identify areas with high-risk scores. The

user may choose to generate an action plan for risk areas that must be resolved, the resolution

expected by a target date. The system allows the user to track progress and re-calculate the

compliance score at future dates. The user compares the recalculated score to the original in

hopes of seeing a decrease. Therefore, it would have been obvious to one of ordinary skill in the

art at the time of the invention to allow the user of Buddle et al. to project the compliance score

for a future date utilizing the algorithm and data of the system in order to more efficiently

communicate the progress of action plan to the user, thus allowing the user to more efficiently

resolve the issue in a timely manner. See column 1, lines 40-47, which discusses the importance

of complying with an action plan and see column 10, lines 23-45, which discusses the systems

need to drive issue resolution and closure in a timely manner.

16.   As per claim 4, Buddle et al. teaches the computer tracking whether said expected

compliance scores have been met, said tracking including calculating actual compliance scores

for said target dates (See column 5, lines 15-30 and 39-51, column 9, lines 35-50, column 10,

lines 23-42, column 11, lines 5-15 and 58-67, which discusses calculating actual compliance

scores on target dates).

17.   As per claim 5, Buddle et al. teaches the step of the computer displaying action plan

status as the action plan progresses towards resolution as well as the display of a graph (See

column 10, lines 20-45 and line 65-column 11, line 5 and line 55-column 12, line 5). Buddle et

al. further expects risk resolution and expects mitigation of risk, which is recalculated (See9,

lines 1-10 and 34-60). However, Buddle et al. does not expressly disclose displaying said

expected compliance scores versus said actual compliance for the target dates.

Buddle et al. discloses displaying compliance scores, displaying graphs, and generating

comparisons of previous and current scores. Buddle et al. further discloses tracking and

displaying status of an action plan. Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to graph the expected score versus the actual score in

order to more efficiently communicate the progress of action plan to the user, thus allowing the

user to more efficiently resolve the issue in a timely manner. See column 1, lines 40-47, which

discusses the importance of complying with an action plan and see column 10, lines 23-45,

which discusses the systems need to drive issue resolution and closure in a timely manner.

18.   Claim 11 contains equivalent limitations to claim 3 and is therefore rejected using the art

and rationale as applied above.

19.   Claim 14 is substantially similar to claims 1 and 2 above and is therefore rejected using

the same art and rationale as applied above. Furthermore, discloses (g) the computer calculating

a compliance score at a future date, said expected compliance score being a function of said

assigned weights, said fully compliant control procedures, and said action plan target dates for

said non-fully complaint control procedures (See column 5, lines 15-30 and 39-51, column 9,

lines 35-50, column 10, lines 23-42, column 11, lines 5-15 and 58-67, which discusses target

dates). However, Buddle et al. does not expressly disclose calculating an expected compliance

score for a future date in advance.

Buddle et al. discloses identifying risk issues that need to be resolved in a timely manner.

Buddle et al. discloses calculating a current compliance score by utilizing the compliance ratings

and weights. This compliance score allows the user to identify areas with high-risk scores. The

user may choose to generate an action plan for risk areas that must be resolved, the resolution

expected by a target date. The system allows the user to track progress and re-calculate the

compliance score at future dates. The user compares the recalculated score to the original in

hopes of seeing a decrease. Therefore, it would have been obvious to one of ordinary skill in the

art at the time of the invention to allow the user of Buddle et al. to project the compliance score

at the future date utilizing the stored algorithm and data in order to more efficiently communicate

the progress of action plan to the user, thus allowing the user to more efficiently resolve the issue

in a timely manner. See column 1, lines 40-47, which discusses the importance of complying

with an action plan and see column 10, lines 23-45, which discusses the systems need to drive

issue resolution and closure in a timely manner.

20.   As per claim 15, Buddle et al. teaches wherein said action plan comprises a signal

indicating whether said non-fully compliant rating is accepted or not accepted, said expected

compliance score further being a function of said non-fully compliant ratings which have been

accepted (See column 8, line 56-column 9, line 33, wherein the not fully compliant procedure is

either accepted or not accepted (acted on or not acted on)).

21.   Claim 17, elements a and b, are substantially similar to claim 2 and are rejected using the

same art and rationale as applied above. Furthermore, element (c) is substantially similar to

claim 14, element g, and is therefore rejected using the same art and rationale as applied above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737.

The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 9, 2005

SUSANNA M. DIAZ
PRIMARY EXAMINER

AU 3623